

REMARKS

This Amendment and Response is intended to fully respond to the Office Action dated May 16, 2003. In that Office Action, claims 1-7 and 9-20 were examined in the Office Action; claims 45-53 were withdrawn from consideration as directed to a non-elected invention; claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by Langen (USPN 5,290,067); claims 2-7 and 9-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Langen (USPN 5,290,067) in view of Kassab (USPN 6,258,200).

In this response, claims 1 and 21-53 have been canceled without prejudice and claim 2 has been amended. Claims 2-7 and 9-20 are now pending. Reexamination and reconsideration of the rejections are respectfully requested in light of the enclosed amendments and these remarks.

Claim Rejections – 35 U.S.C. § 102

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Langen (USPN 5,290,067). Claim 1 has been canceled above thereby rendering this rejection moot.

Claim Rejections – 35 U.S.C. § 103

Claims 2-7 and 9-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Langen (USPN 5,290,067; hereinafter “Langen”) in view of Kassab (USPN 6,258,200; hereinafter “Kassab”). Applicant respectfully traverses these rejections. In order to establish *prima facie* obviousness under 35 U.S.C. § 103(a), three basic criteria must be met, namely: (1) there must be some suggestion or motivation to combine the references or modify the reference teaching; (2) there must be a reasonable expectation of success; and (3) the reference or references when combined must teach or suggest each claim limitation. Applicant submits that

the Office Action failed to state a *prima facie* case of obviousness, and therefore the burden has not properly shifted to Applicant to present evidence of nonobviousness. Applicant respectfully asserts that Langen and Kassab fail to disclose or suggest all of the limitations of the pending claims, either alone or in combination. Specifically, Applicant asserts that the references do not disclose a substantially transparent information sheet with printed MSRP information on the sheet, wherein the sheet exhibits static cling properties. Applicant also asserts that there is no suggestion or motivation to combine the references or modify the reference teaching in such a manner as to obtain the claimed invention.

Langen is directed to an MSRP label that has “repositionable adhesive strips.” The purpose of these strips is to provide a sticker that can be easily removed and repositioned on a window without leaving a residue. Clearly, as stated in the background of the Langen reference, one problem that Langen’s invention overcame was the ripping of MSRP labels when the window was rolled down. (Langen col. 1, ll. 28-30). In order to overcome this problem, Langen used repositionable adhesive strips that allow the label to “be removed from the window and repositioned as desired.” (Langen col. 2, ll. 50-52 and col. 5, ll. 16-18). Given the purpose behind the repositionable adhesive strips, Langen clearly does not teach or suggest that an MSRP label can be kept on a window while rolling the window down, and provides a simple method of removing the label while driving if desired. That is, although Langen states that the label may be transparent, there is simply no discussion or teaching of the benefits of such a transparent label. As a result, one skilled in the art reads Langen for what it teaches, an improved MSRP label is one that has repositionable adhesive strips so that the label can be removed while driving and/or rolling down a window. As a result of these repositionable adhesive strips, Langen does not teach the use of any other method of attaching, such as static cling.

Indeed, through the advanced process of adding these strips to the label, there is simply no teaching of using static cling as defined in the present invention. Langen teaches a two-component product, i.e. a label that has added elements, namely adhesive strips. Langen, therefore, does not disclose, either explicitly or inherently the integral label having cling-type properties as defined in the present claims.

Kassab does not satisfy the deficiencies of Langen. Kassab is directed to a method for affixing stickers and artwork to surfaces and particularly car windows that allows for easy removal. Kassab is not concerned with providing substantially transparent sheets or improving driver vision while complying with the law. In fact, Kassab clearly states that the stickers and artwork are primarily non-transparent. "In addition, having too many city stickers 30 mounted on the windshield creates blind spots thereby reducing a driver's vision through the windshield 12." Kassab, Col. 8, lines 1-4. In addition, Kassab recommends removing any extra static-cling film in FIG. 6 and it related discussion. "The portions of the static-cling film 20 that extend beyond the windshield sticker 30 are trimmed to conform to the size of the windshield sticker 30." Kassab, Col. 6, lines 33-36. While the affixing device in Kassab (the static-cling film) may be transparent, it is clear that the resulting sticker/film combination is not substantially transparent. Furthermore, the static-cling film is not analogous to an information sheet as it has no information on it - it is blank - until a sticker or artwork is affixed to it (rendering the combination no longer substantially transparent). As a result, Kassab clearly does not show the substantially transparent information sheet element of claims 2, 11 and 16.

The combination of Langen with Kassab also does not disclose the integral transparent information sheet that having both the MSRP information and the static-cling properties of the claimed invention. Indeed, the combination of Langen with Kassab would result in attaching

repositional adhesive strips to a clear, static-cling film, which makes no sense. Clearly, the purpose behind Kassab is to allow a driver the ability to easily remove a label that otherwise was not easily removable. Langen's label does not fit within this category as it is already easily removable. Consequently, not only would one not combine Langen with Kassab, the combination does not disclose, either explicitly or inherently, an integral transparent information sheet that has both the MSRP information and the static-cling properties. Since, the combination of Langen with Kassab does not disclose the integral transparent information sheet that having both the MSRP information and the static-cling properties, the references do not render claims 2-7 and 9-20 obvious as a matter of law. Reconsideration of the § 103 rejection is hereby requested.

In addition to failing to teach or suggest all of the limitations of the claims, the references do not provide a teaching or suggestion to combine the references such that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established. As mentioned above, there is absolutely no suggestion in Langen to modify its teachings to use something other than adhesive strips, let alone use static-cling properties as a means for adhering the label to the window. More importantly, there is no suggestion or reason to combine Kassab with Langen. Kassab transforms labels that are not easily removable and makes them so. However, there is no reason to use Kassab for a label that is already easily removable such as Langen. Accordingly, there is no suggestion to combine the references, and in fact, Langen teaches away from combining the references. That is, since Langen provides an easily removable label, there is no reason to combine Langen with Kassab. For this additional reason, claims 2-7 and 9-20 should be allowed over the Langen and Kassab as the Examiner has failed to establish a *prima facie* case of obviousness.

With respect to claims 15 and 20, the Examiner cites *In re Gulack* (217 USPQ 401, (CAFC 1983)) as support for stating that the MSRP information does not patentably distinguish the present invention from Kassab. The Applicant respectfully traverses this conclusion, because *Gulack*, as it relates to the present invention supports the finding that the MSRP information alone patentably distinguishes the present invention from Kassab. *Gulack* states that "[w]here the printed subject matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art." *Gulack* 217 USPQ 401 at 403. The test in *Gulack* for functional relationship is "whether there exists any new and unobvious functional relationship between the printed matter and the substrate." Id. The court found in *Gulack* that random items of text on a hat band were not functionally related but that an infinite number series on a ring were functionally related as the ring, also, is infinite.

In the present invention, there is a functional relationship between the MSRP information and the sheet. The MSRP information must be on the car window, but its contrasting background does not, and the transparent sheet allows it to be there safely. In fact, the MSRP information in this case could be considered the substrate as it is the structural element that is required by law to be on the window. The present invention is directed to displaying that element as safely as possible. Therefore, *Gulack* requires the finding that MSRP information does render the present invention patentably distinct from Kassab, wherein the contents of the sticker in Kassab are irrelevant to the affixing device. Therefore pending claims 15 and 20 are patentably distinguishable from Kassab because of this functional relationship.

Furthermore, with regard to claim 16, neither Langen or Kassab discloses or teaches a removable opaque sheet that may be affixed to a substantially transparent information sheet to provide contrast allowing for easy reading of the MSRP information on the transparent

information sheet. Since the references clearly do not show this element of claim 16, they cannot form the basis of a 35 U.S.C. § 103(a) rejection of it.

As claims 2, 11 and 16 are now allowable for the reasons given above, so too are all the claims dependent therefrom. Thus, Applicant respectfully requests that the Examiner withdraw his rejections and find the pending claims allowable.

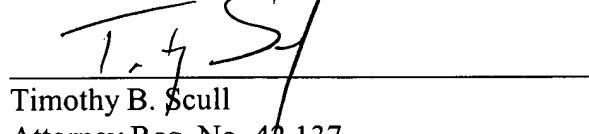
Conclusion

As originally filed, the present application included 43 claims, 6 of which were independent. As the result of a restriction requirement, Applicant elected Claims 1-20 for prosecution, 3 of which are independent. As amended, the present application now includes 18 claims, 3 of which are independent. It is believed no further fees are due with respect to the claims. That said however, Applicant is providing, herewith, the fees for a one-month extension of time and an RCE filing fee. It is believed that no additional fees are due at this time. If the Examiner determines that other fees are due with respect to this application, the Examiner is authorized to charge these fees to deposit account number 13-2725. It is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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